

**REMARKS**

Applicants hereby reply to the Office Action mailed on January 27, 2005, and request a three-month extension of time. Claims 1-11 were pending in the application and the Examiner rejects claims 1-11.

**Double Patenting**

The Examiner provisionally rejects claims 1-11 under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 4, 5, 8, 10, and 19 of copending Application No. 10/708,822, claims 5 and 12 of copending Application No. 10/708,827, claim 38 of copending Application No. 10/708,835, claims 1-11 of copending Application No. 10/708,840, claim 3 of copending Application No. 10/708,824, claim 5 of copending Application No. 10/708,826, claim 2 of copending Application No. 10/708,823, claims 5, 24, and 38 of copending Application No. 10/708,825, claims 5, 24, and 37 of copending Application No. 10/708,834, claims 5, 24, and 37 of copending Application No. 10/708,831, claim 2 of copending Application No. 10/708,838, claims 5, 27, 38, and 41 of copending Application No. 10/708,836, claims 3, 5, and 12 of copending Application No. 10/708,839, claims 5, 28, and 38 of copending Application No. 10/708,833, and claims 5, 24, and 30 of copending Application No. 10/708,828. While Applicants respectfully disagree with these double patenting rejections, in the interest of compact prosecution, Applicants submit terminal disclaimers, without prejudice, in compliance with 37 C.F.R. § 1.321(c). Applicants also assert that this nonstatutory double patenting rejection is based on the above-listed applications, all of which are commonly owned with this application by assignee, American Express Travel Related Services Company, Inc.

**Claim Rejections – 35 U.S.C. § 103(a)—The Haala and Fujii References**

The Examiner advised Applicants that under 37 C.F.R. § 1.56, Applicants are obligated to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made. Applicants respectfully assert that the subject matter of the

various claims was commonly owned at the time the inventions covered therein were made and therefore, 37 C.F.R. § 1.56 does not apply.

The Examiner rejects claims 1-5 and 9-11 under 35 U.S.C. § 103(a) as being unpatentable over Haala, U.S. Patent Application No. 2005/005172 ("Haala") in view of Fujii et al., U.S. Patent No. 6,233,348 ("Fujii"). Applicants respectfully traverse these rejections.

In general, Haala discloses a method and system for preventing a person from negotiating a transaction upon the occurrence of a preselected event such as verification of the biometric sample. Haala teaches proffering a biometric and a data card to a reader in order to negotiate a transaction (paragraph [0038]), wherein the data card is coded to include biometric and profile information about a person (paragraph [0021]). However, Haala limits the profile information to non-financial or non-payment information such as "name, address, date and place of birth, citizenship, medical and/or personal history, criminal record, passport information (date of issuance, number, issuing country, validity period, etc.), immigration or non-immigration visa information (category and duration, issuing consulate/embassy, etc.), licenses (driver's, pilot, etc.)" (paragraph [0035]). As such, Haala does not disclose the use of its transaction card for any type of payment function.

Moreover, Applicants assert that Haala teaches away from the use of a card that performs both biometric verification and payment because Haala discloses that a separate card is needed to conduct the financial transaction. As set forth in Haala, "[i]t is noted herewith that the security system of the present invention is not meant to substitute other conventional identification systems that are currently used to check or verify the validity or authenticity of persons or cards, such as credit cards...the crosscheck security system...functions as a prerequisite to conventional transaction systems where, for example, a credit card or other security card is used to obtain goods or services" (paragraph [0028]).

The Examiner states that although "Haala is silent as to a smart card and verifying the proffered biometric sample, it would have been well within the skill in the art to use a smart card in order to accommodate increased security and storage demands." Applicants assert that Fujii

merely teaches registering fingerprint biometrics and identifying various characteristics associated with fingerprints. Fujii does not teach or disclose associating biometrics with a smartcard payment account. Fujii teaches away from associating the fingerprint biometric with a card because Fujii teaches the use of recognizing only fingerprint characteristics (col. 39, lines 60+ and col. 40, lines 1-65) instead of "using an ID card or password" (col. 1, lines 19-21). Thus, there is no motivation to combine Haala and Fujii because Haala requires a card for verification, but Fujii only uses fingerprint characteristics without any card. Accordingly, neither Haala, Fujii nor any combination thereof disclose or suggest "associating said proffered biometric sample with a smartcard such that said smartcard system utilizes said proffered biometric sample to authorize a smartcard payment utilizing said smartcard," as recited in independent claim 1.

Claims 2-5 and 9-11 depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 2-5 and 9-11 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 2-5 and 9-11.

**Claim Rejections – 35 U.S.C. § 103(a)—The Haala and Robinson References**

The Examiner additionally rejects claims 6-8 under 35 U.S.C. § 103(a) as being unpatentable over Haala in further view of Robinson, U.S. Patent Application No. 2003/0061172 ("Robinson"). Applicants respectfully traverse these rejections.

Claims 6-8 directly or indirectly depend from claim 1 and contain all of the elements thereof. Therefore, Applicants respectfully submit that claims 6-8 are differentiated from the cited references at least for the same reasons as set forth above, in addition to their own respective features. Accordingly, Applicants respectfully request withdrawal of the rejection of claims 6-8.

Applicants respectfully submit that the pending claims are in condition for allowance.

No new matter is added in this Reply. Reconsideration of the application is thus requested. The

Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account No. 19-2814. Applicants invite the Examiner to telephone the undersigned if the Examiner has any questions regarding this Reply or the present application in general. A duplicate copy of this request is enclosed for your use.

Respectfully submitted,

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